

U. S. Application No. 10/717,26
Attorney Docket No. 2002B171/2
Reply to Office Action of July 14, 2006
Amendment dated October 10, 2006

RECEIVED
CENTRAL FAX CENTER
JAN 09 2007

REMARKS/ARGUMENTS

Reconsideration of the claims in view of these amendments and remarks is respectfully requested. Applicants have withdrawn claims 1-37 from consideration, therefore Claims 38-61 are before the Examiner. Applicants request reconsideration of the pending claims in light of the arguments and amendments made herein.

AMENDMENTS TO THE DETAILED DESCRIPTION

Applicants have amended several paragraphs in this response to correct typographical errors or an error in identification of 2-methyl-1,5-hexadiene as an α , internal nonconjugated diene. This diene, 2-methyl-1,5-hexadiene, was previously disclosed in the detailed description, however, it was mistakenly labeled as an α , internal non-conjugated diene. One of ordinary skill in the art would recognize that this was an error, and that 2-methyl-1,5-hexadiene is not an α , internal non-conjugated diene. One of ordinary skill in the art would also recognize that the appropriate correction would be that one of the dienes in the polymer composition could be either 2-methyl-1,5-hexadiene or an α , internal non-conjugated diene.

As one of ordinary skill in the art would not only recognize the errors in the specification but would also recognize the appropriate correction, the amendments to the detailed description are not new matter. See M.P.E.P. §2163.07(II) citing *In re Oda*, 443 F.2d 1200 (CCPA 1971) ("An amendment to correct an obvious error does not constitute new matter where one skilled in the art would not only recognize the existence of error in the specification, but also the appropriate correction.").

AMENDMENTS TO THE CLAIMS

Applicants have amended pending claims 38, 42, 43 and 44 to reflect (1) the first diene units being derived from either 2-methyl-1,5-hexadiene or α , internal nonconjugated diene monomers, (2) the second diene units being derived from α , ω nonconjugated diene monomers. Applicants have also amended withdrawn claims 21, 22 and 23.

U. S. Application No. 10/717,261
Attorney Docket No. 2002B171/2
Reply to Office Action of July 14, 2006
Amendment dated October 10, 2006

No new matter has been added.

35 U.S.C. § 102(b)

Claims 38, 40-42, 44-53 and 55-61 were rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 4,987,193 to Gotoh ("Gotoh") for the reasons stated on pages 2-3 of the Action. Applicants respectfully disagree.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP §2131, *citing Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Gotoh cannot anticipate Applicant's claims because, as is discussed below, Gotoh does not disclose the propylene, α , internal nonconjugated diene ("AIN") (or 2-methyl-1,5-hexadiene, an AIN like diene) and α , ω internal nonconjugated diene ("AON") terpolymers of Applicant's claims.

Applicant has amended claim 38 (and claims 39-61 by dependency) to require the terpolymer to be composed of the following: (1) propylene-derived units, (2) first diene units derived from 2-methyl-1,5-hexadiene or an AIN and (3) second diene units derived from an AON, where each of the first and second diene units have 5 or more carbon atoms.

Gotoh, in contrast, discloses a polymer (and process for making the same) consisting essentially of (1) 84-99.5 mol % propylene, (2) 0-15 mol% ethylene and (3) 0.5-15 mol% 6-methyl-1,6-octadiene and/or 7-methyl-1,6-octadiene. *See* Gotoh, col. 2, lns. 28-35, col. 4, lns. 38-55, claim 1. Gotoh expressly limits its terpolymer to include only diene units derived from AINs.¹

Gotoh, therefore, expressly excludes a polymer comprised of AON-derived units as claimed by Applicant in the instant application.

¹ 6-methyl-1,6-octadiene and 7-methyl-1,6-octadiene both possess double bonds at the 1 and 6 positions of the carbon backbone and, therefore, are both α , internal nonconjugated dienes.

U. S. Application No. 10/717,26
Attorney Docket No. 2002B171/2
Reply to Office Action of July 14, 2006
Amendment dated October 10, 2006

Therefore, in the absence of any disclosure in Gotoh of Applicants' claimed limitations, and upon the evidence adduced by Applicants in this response, Applicants respectfully submit that the claimed invention is not anticipated and request that the rejection be withdrawn.

CLAIM REJECTIONS—35 U.S.C § 103

Claims 39, 43 and 54 were rejected under 35 U.S.C. § 103(a) as being obvious over Gotoh ("Gotoh") for the reasons stated on pages 3-4 of the Action. Applicants respectfully disagree.

In light of the amendments and the arguments above, Applicant believes claims 39, 43 and 54 are patentable independent of the amount of a diene unit present in, or the melting temperature of, the polymer composition. MPEP §2143.03 ("If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.") *citing In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Without extensively repeating the arguments made above, Gotoh does not disclose a terpolymer comprising propylene-derived units, AIN-derived units and AON-derived units and, therefore, cannot render Applicant's claims obvious. MPEP §2143.03 ("To establish a prima facie case of obviousness of a claims invention, all the claim limitations must be taught or suggested by the prior art.") *citing In re Royka*, 490 F.2d 981 (C.C.P.A. 1974).

Therefore, in the absence of a reference or concrete evidence explicitly supporting the Examiner's assertions predicated upon sound technical and scientific reasoning, Applicant respectfully submits that the claimed invention is not obvious and requests that the rejection be withdrawn.

CONCLUSION

Having demonstrated that the cited references fail to disclose the invention as claimed, all remaining objections and rejections having been overcome, this application is in condition for allowance. Accordingly, Applicant requests early and favorable reconsideration in the form of a Notice of Allowance.

U. S. Application No. 10/717,266
Attorney Docket No. 2002B171/2
Reply to Office Action of July 14, 2006
Amendment dated October 10, 2006

If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated, since this should expedite the prosecution of the application for all concerned.

If necessary to affect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to affect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1712 (Docket #: 2002B171/2).

Respectfully submitted,



Shawn H. Foster
Attorney for Applicants
Registration No. 56,538

October 10, 2006
Date

ExxonMobil Chemical Co.
Law Technology
P.O. Box 2149
Baytown, Texas 77522-2149
Phone: 281-834-2173
Fax: 281-834-2495